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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/670,003

09/25/2003

Seong-Sik Choi

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01/14/2005

Docketing Department
HOWREY SIMON ARNOLD & WHITE, LLP
1299 Pennsylvania Avenue, NW
Box No. 34
Washington, DC 20004-2402

EXAMINER

SAWHNEY, HARGOBIND S

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,003

Applicant(s)

CHOI, SEONG-SIK

Examiner

Hargobind S Sawhney

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/25/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 7-27 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims of prior U.S. Patent No. 6,626,550 B2 as follows:

Instant Application No. 10,670,003	U. S. Patent No. 6,626,550 B2	Discussion on differences, and additional References:
Claims 7-13	Claims 7-13	Claims 7-13 of the instant application are identical to respective claims 7-13 of U. S. Patent No. 6,626,550 B2
Claims 14-19	Claims 17, 14, 18, 15, 19 and 16	Claims 14-19 of the instant application are identical to claims respective 17, 14, 18, 15, 19 and 16 of U. S. Patent No. 6,626,550 B2
Claims 20 and 21	Claims 20 and 21	Claims 20 and 21 of the instant application are identical to respective claims 20 and 21 of U. S. Patent No. 6,626,550 B2.

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Instant Application No. 10,670,003	U. S. Patent No. 6,626,550 B2	Discussion on differences, and additional References:
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Claims 22-27	Claims 25, 22, 26, 23, 27 and 24	Claims 22-27 of the instant application are identical to claims respective 25, 22, 26, 23, 27 and 24 of U. S. Patent No. 6,626,550 B2.
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This is a double patenting rejection.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-6 are rejected under the judicially created doctrine of double patenting over claims respective claims 1, 2, 5, 3, 6 and 4 of U. S. Patent No. 6,626,550 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Instant Application No. 10,670,003	U. S. Patent No. 6,626,550 B2	Discussion on differences, and additional References:
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Claim 1	Claim 1	<p>U. S. Patent No. 6,626,550 B2, Claim 1 recites:</p> <ul style="list-style-type: none">- a plate-shaped body; <u>Claim 1, line 4;</u><ul style="list-style-type: none">- at least one light guide projection for fitting said light guide panel disposed on left and/or right side of said plate-shaped body; <u>Claim 1, lines 5-7</u>- the light guide projection having an upper surface, a lower surface, a first side surface disposed parallel to the left and/or right side of said plate-shaped body; a second side surface disposed adjacent the first side surface and remote from the light source, and a third side surface disposed adjacent to the first side surface and the light source; <u>Claim 1, lines 7-14</u>- a plurality of patterns formed on a lower surface of said plate-shaped body to uniformly project light; and the upper surface and the lower surface of said light guide projection being disposed remote
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Instant Application No. 10,670,003	U. S. Patent No. 6,626,550 B2	Discussion on differences, and additional References:
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Claim 1 cont'd.	Claim 1	from planes extending from said plate- shaped body; <u>Claim 1, lines 15-19</u>
Claims 2-6	Claims 2, 5, 3, 6 and 4 respectively	Claims 2, 5, 3, 6 and 4 of U. S. Patent No. 6,626,550 B2 include same limitations as that recited in respective claims 2, 5, 3, 6 and 4 of U. S. Patent No. 6,626,550 B2.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to meet the limitations of claims 1-6 of the instant application with the structural limitations included in respective claims 2, 5, 3, 6 and 4 of U. S. Patent No. 6,626,550 B2.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S Sawhney whose telephone number is 571 272 2380. The examiner can normally be reached on 6:15 - 2:45.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571 272 2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HSS

11/10/2004



Sandra O'Shea
Supervisory Patent Examiner
Technology Center 2800